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09/560,473	04/28/2000	William S Johnson JR.	2400-418	3792

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EXAMINER
KISS, ERIC B

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/560,473	JOHNSON, WILLIAM S
	Examiner	Art Unit
	Eric B. Kiss	2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-38_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-38_ is/are rejected.

7) ☒ Claim(s) _13_ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _28 April 2000_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _2, 3, 5_ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   Claims 1-38 have been examined.

Drawings

2.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "30" in Fig. 1 and "414" and "416" in Fig. 6. References "414" and "416" apparently correspond to portions of the specification in the last two paragraphs on page 17. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3.   The disclosure is objected to because of the following informalities:

Recitation of "(block 268)" on page 15, line 3, should apparently read --(block 368)--.

Reference to "the previously incorporated application" on page 9, line 16 is improper because two different applications were previously incorporated (see page 1, lines 6-8, and page 8, lines 16-18). This reference is presumably referring to "FUEL DISPENSING SYSTEM PROVIDING CUSTOMER PREFERENCES", the secondly cited application.

Appropriate correction is required.

Claim Objections

4.   Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for

failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

claim(s) in independent form. Claim 13 recites the limitation of "providing a portable computing

device to said individual". However, parent claim 12 already recites "an individual equipped

with a portable computing device" in line 2.

Double Patenting

5.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37
CFR 3.73(b).

6.   Claims 1-38 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-34 of copending

Application No. 09/611,087 in view of U.S. Patent No. 6,442448 to Finley et al. The following

example is given in which the actual claim language of Application '087 is underlined for clarity.

As per claims 1, 2, and 11 of the instant application, '087 claims (in claim 1):

A method of upgrading software at a remote fueling site from a computer system (a

location remote from a corporate computer) comprising:

accessing a site controller at the remote fueling site (computer at a remote location) with

the computer system (corporate computer);

evaluating a database to determine what software upgrades may be available to said

remote fueling site; and

downloading a software upgrade to said site controller from the computer system

(uploading a software upgrade to said computer at said remote location) based on said

evaluating.

'087 does not claim downloading the software upgrade to a portable computing device or

using a portable computing device to access the computer at a remote location. However, Finley

teaches accessing a remote computer/site controller (Site Manager (SM)) using a portable

computing device (technician's laptop connected to a service serial port) for the purpose of

diagnostics and setup (upgrading; see column 10, line 62 through column 12, line 7, and in

particular, column 11, lines 32-38). Finley furthermore suggests equivalence between the

service serial port and an Ethernet port also disclosed for the purpose of a network connection

(see Finley, column 11, lines 28-31, and lines 34-38 for equivalence). Therefore, it would have

been obvious to one having ordinary skill in the computer art at the time the invention was made

to modify the claimed method of Application '087 to include using a portable computing device

to transfer upgrades to the remote computer/site controller as per the teachings of Finley. One

would be motivated to do so to allow on-site access to the remote computer through a

technician's portable interface.

This is a <u>provisional</u> obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

8.   Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claim 16 recites the limitation "said database" in line 2. There is insufficient antecedent

basis for this limitation in the claim. Although parent claim 12 recites "a database" in the

preamble, it is recited as a final product of the method and not explicitly linked to the method

steps in the body that lead to the generation of a plurality of records that do not necessarily

constitute a database. Accordingly, this preamble recitation of "a database" is given little

patentable weight. In the interest of compact prosecution, this limitation is subsequently treated

as reading "said plurality of records" for the purpose of further examination.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 1-7, 10-16, 27, and 29-38 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 5,155,847 to Kirouac et al. in view of U.S. Patent No.

6,442448 to Finley et al.

As per claim 1, Kirouac teaches downloading a software upgrade from a corporate

computer (central computer system) to a computer at a remote location (see column 1, line 56

through column 2, line 15) but fails to teach downloading a software upgrade to a portable

computing device and accessing a computer at a remote location with the portable computing

device. However, Finley teaches accessing a remote computer (Site Manager (SM)) using a

portable computing device (technician's laptop connected to a service serial port) for the purpose

of diagnostics and setup (upgrading; see column 10, line 62 through column 12, line 7, and in

particular, column 11, lines 32-38). Therefore, it would have been obvious to one having

ordinary skill in the computer art at the time the invention was made to modify the method of

Kirouac to include using a portable computing device to transfer upgrades to the remote

computer as per the teachings of Finley. One would be motivated to do so to allow on-site

access to the remote computer through a technician's portable interface.

As per claims 2 and 11, in addition to the teachings applied above, Finley further teaches

a remote location comprising a fueling site (see column 2, lines 65 and 66) and accessing a site

controller at a fueling site (Site Manager; see column 3, lines 5-27 and column 10, line 62

through column 12, line 7). Therefore, it would have been furthermore obvious to one having

ordinary skill in the computer art at the time the invention was made to further modify the

method of Kirouac to include the remote location comprising a fueling site and accessing a site

controller at the fueling site as per the teachings of Finley. One would be motivated to do so to

allow for upgrading of software within such a fueling site environment that also comprises

computer systems.

As per claim 3, Kirouac further teaches storing a record indicative of a quantity of

upgrades performed (program history section; see column 5, lines 19-61). Therefore, for reasons

stated previously, such a claim also would have been obvious.

As per claim 4, Kirouac teaches downloading a software upgrade from a corporate

computer (central computer system) to a computer at a remote location (see above applied

teachings) but fails to explicitly teach downloading the software upgrade from the computer to a

peripheral device. However, Finley suggests downloading a software upgrade to a peripheral

device (see column 15, line 59 through column 16, line 7). Therefore, it would have been

obvious to one having ordinary skill in the computer art at the time the invention was made to

further modify the method of Kirouac to include downloading a software upgrade from a computer to a peripheral device as per the teachings of Finley. One would be motivated to do so to insure that all downstream software components (such as in a replaceable hardware module) are exactly what they are supposed to be.

As per claims 5-7 and 10, Kirouac teaches using a client database to compile and store a plurality of records, each record indicative of a hardware (group) and software configuration of a remote computer (see column 9, lines 38-63) and subsequently providing the record to the corporate computer (central computer; see column 13, lines 3-18). Therefore, for reasons stated previously, such claims also would have been obvious.

As per claims 12, Kirouac teaches polling hardware and software existent at a remote site and storing a plurality of records, each record relating to hardware and software configuration at different remote sites (see column 9, lines 38-63), and uploading the plurality of records to a corporate computer (central computer; see column 13, lines 3-18). Kirouac fails to teach sending an individual equipped with a portable computing device to a plurality of remote sites, the remote sites being fueling sites, and using a portable computer for the step of polling. However, Finley teaches performing software upgrades at a fueling site (column 15, line 59 through column 16, line 7) and suggests sending an individual equipped with a portable computing device to the remote fueling site (see column 11, lines 32-38 and column 25, lines 14-19) and using the portable computing device for acquiring/polling and updating (diagnostics and setup) information at the remote fueling site (see column 11, lines 32 and 33). Therefore, it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to modify the Kirouac method to include sending an individual equipped with a portable

computing device to remote fueling sites as part of creating, storing, and transmitting records related to fueling site hardware and software configuration as per the teachings of Finley. One would be motivated to do so to allow for configuration monitoring at fueling sites that contain computer hardware and software.

As per claim 13, see the rationale applied above to claim 12, wherein the limitation of "an individual equipped with a portable computing device" has already been addressed.

As per claim 14, in addition to the teachings applied above, Finley further teaches a web-based interface (SMTP email client) through which data can be sent to a corporate computer (see column 24, lines 47-59). Therefore, it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to include such a web-based interface for communicating with a corporate computer. One would be motivated to do so to provide a standard protocol for data communication.

As per claim 15, in addition to the teachings applied above, Finley further suggests polling (using the portable computing device for acquiring/polling information at the remote fueling site) through a site controller (Site Manager (SM); see column 3, lines 5-27 and column 10, line 62 through column 12, line 7). Therefore, for reasons applied above, such a claim also would have been obvious.

As per claim 16, Kirouac further teaches generating recommendations as to potential upgrades from the plurality of records (see column 9, lines 34-63). Therefore, for reasons applied above, such a claim also would have been obvious.

As per claim 27, this is a device version of the claimed method steps discussed above (claim 6), wherein all claim limitations have been addressed as set forth above. Thus, accordingly, such a claim also would have been obvious.

As per claim 29, Kirouac further teaches installing a patch to enable functioning of a software upgrade package at a remote location (see column 13, lines 13-18). Therefore, for reasons applied above, such a claim also would have been obvious.

As per claim 30, this is a system version of the claimed method steps discussed above (claim 7), wherein all claim limitations have been addressed as set forth above. Thus, accordingly, such a claim also would have been obvious.

As per claim 31, official notice is taken that it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to record commission related data based on a number of software upgrade installations performed by a portable computing device (and corresponding technician). One would be motivated to do so to promote an efficient work schedule for a technician traveling to several remote sites by paying per upgrade rather than per hour worked.

As per claim 32, this is a system version of the claimed method steps discussed above (claim 2), wherein all claim limitations have been addressed as set forth above. Thus, accordingly, such a claim also would have been obvious.

As per claim 33, this is a system version of the claimed method steps discussed above (claim 2), wherein all claim limitations have been addressed as set forth above, including the portable computing device being a laptop computer (technician's laptop connected to a service

serial port; column 11, lines 32-38 of Finley as cited above). Thus, accordingly, such a claim also would have been obvious.

As per claim 34, Official notice is taken that with regards to performing the prescribed tasks, including receiving and transferring software data, and having the property of being a portable computing device, a personal digital assistant would have been recognized by one having ordinary skill in the computer art at the time the invention was made to be an equivalent of a laptop computer. Therefore, for reasons applied above, such a claim also would have been obvious. One would have been motivated to use a personal digital assistant instead of a laptop because they are art-recognized equivalents.

As per claims 35 and 36, in addition to the teachings applied above, Kirouac further teaches determining upgrades needed at a remote site and communications means for accessing the corporate computer (see column 9, lines 24-38). Therefore, for reasons applied above, such a claim also would have been obvious.

As per claim 37, this is a system version of the claimed method steps discussed above (claim 11), wherein all claim limitations have been addressed as set forth above. Therefore, for reasons applied above, such a claim also would have been obvious.

As per claim 38, in addition to the teachings applied above, Finley further teaches the Site Manager being a gateway or portal to access the fuel dispensers at the fueling site (see column 12, lines 25-34). Therefore, a device such as the technician's laptop already discussed would be adapted to communicate with a fuel dispenser (through the Site Manager). Therefore, it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to further modify the system of Kirouac to include transferring means

adapted to communicate with a fuel dispenser as per the teachings of Finley. One would be

motivated to do so to allow for data transfer to/from a fuel dispenser.

11.   Claims 8, 9, 17-26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Kirouac in view of Finley as applied to claims 1 and 27 above, and further in view of U.S.

Patent No. 6,247,128 to Fisher et al.

As per claims 8 and 9, Kirouac and Finley teach downloading a software upgrade from a

corporate computer using a portable computer device (see above applied teachings) but fail to

teach subsequently accessing said corporate computer to secure an accounting for upgrades or

accounting for royalties due a third party based on said upgrades installed. However, Fisher

teaches accessing a corporate computer (a database network at manufacturing headquarters

including royalty tracking systems) to account for royalties due to third-party software providers

based on installed software components (see column 11, lines 44-55). Therefore, it would have

been obvious to one having ordinary skill in the computer art at the time the invention was made

to further modify Kirouac and Finley to include securing an accounting, including royalties, for

software upgrades installed as per the teachings of Fisher. One would be motivated to do so to

enable meeting payment obligations for software installed.

As per claim 17, method steps comprising each of these limitations have already been

addressed as set forth above (relative to claims 3, 8, and 12). Therefore, for reasons applied

above, such a claim also would have been obvious.

As per claim 18, method steps comprising each of these limitations have already been addressed as set forth above (relative to claims 3, 9, and 12). Therefore, for reasons applied above, such a claim also would have been obvious.

As per claim 19, official notice is taken that it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to record commissioning obligations. One would be motivated to do so to promote an efficient work schedule for a technician traveling to several remote sites by paying per upgrade rather than per hour worked.

As per claims 20, 21, and 23, method steps comprising each of these limitations have already been addressed as set forth above (relative to claims 3, 8, and 12). Therefore, for reasons applied above, such claims also would have been obvious.

As per claims 22 and 24, Kirouac further teaches storing a version number associated with each upgrade and storing a version number associated with software existent prior to an upgrade (see column 9, lines 34-53). Therefore, for reasons applied above, such claims also would have been obvious.

As per claims 25 and 26, official notice is taken that it was well known and common practice in the computer art at the time the invention was made to determine if upgrading resulted from a warranty contract, i.e. checking to see if a registered software component is within a warranty period at the time of upgrade, and accounting for a remote site if upgrading fell outside of any warranty contract obligation, i.e. if the warranty is expired, charging for said upgrading. One would be motivated to do so to ensure that services rendered comply with warranty obligations and appropriate fees, if any, are collected. Therefore, for reasons applied above, such claims also would have been obvious.

As per claim 28, this is a device version of the claimed method steps discussed above (relative to claims 6-8), wherein all claim limitations have been addressed as set forth above. Thus, accordingly, such a claim also would have been obvious.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703) 308-4789.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, DC 20231
Or faxed to:
(703) 746-7239 (for formal communications intended for entry)
Or:
(703) 746-7240 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

EBK
November 12, 2002

ANIL KHATRI
PRIMARY EXAMINER